

Appln. No. 09/752,037
Amendment dated September 13, 2006
Reply to Office Action mailed June 15, 2006

REMARKS

Reconsideration is respectfully requested.

Claims 1, 3 through 20, 22 through 37, 39 through 48, and 50 through 53 remain in this application. Claim 2, 21, 38 and 49 have been cancelled. No claims have been withdrawn or added.

Paragraphs 1 through 5 of the Office Action

Claims 1 through 3, 6 through 14, 17 through 29, 31 through 42, 44 through 48 and 50 through 55 have been rejected under 35 U.S.C. §102(b) as being anticipated by Khalid.

Claims 4, 5, 15, 16, 30 and 43 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Khalid in view of Patsiokas.

Claim 1 has been amended to include the requirements of claim 2, which was rejected with claims 11, 21, 24, 26, 33, and 38, and thus claim 1 now requires "if the communication device is in the privacy operating mode, routing the call to a message system if no privacy mode code is entered by the caller", it is alleged in the Office Action that:

Regarding claims 2, 11, 21, 24, 26, 33, and 38, Khalid further teaches if the communication device is in the privacy operating mode, routing the call to a message system if no privacy mode code is entered by the caller (Col. 4, lines 31-32).

However, looking to the referenced portion of the Khalid patent, it states at col. 4, lines 31 through 32 that:

The series of digits is either of a fixed length, or the subscriber indicates the end of the series of digits by pressing a special function key on telephone 31.

It is not seen how this could disclose to anyone skilled in the art the claimed feature of "routing the call to a message system if no privacy mode code is entered by the caller" "if the communication device is in the privacy operating mode".

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The Khalid patent further states at col. 2, lines 36 through 44 that (all emphasis added):

In another preferred embodiment of the present invention, the subscriber can place the subscriber's telephone in a do not disturb mode in which a busy signal is returned to every caller. In this case, when a caller first calls the subscriber's telephone when the subscriber's telephone is in the do not disturb mode, the busy signal is returned to the caller. Upon the caller entering the pass code, a ringing pattern is applied to the subscriber's telephone and a ring back signal is returned to the caller.

This further confirms that there is no routing of the caller to a messaging system when the system is placed in the Do Not Disturb mode. It is therefore submitted that the Khalid patent could not lead one of ordinary skill in the art to the requirements of claims 1, 11, 21, 24, 26, 33, and 38.

Claim 9 requires "if the communication device is in the privacy operating mode, providing a privacy mode message including a selected privacy override code to the caller".

In the rejection of the Office Action, it is alleged that:

If the communication device is in the privacy mode, providing a privacy mode message including a selected privacy override code to the caller (Col. 2, lines 60-63).

The Khalid patent states at col. 2, lines 60 through 63 that:

In some situations, a call directed to the subscriber can get diverted to an adjunct processing system such as voice mail systems, auto-attendant, or an automatic call distribution (ACD) system. However, nothing here indicates or suggests that any "privacy mode message" is provided to the caller, and nothing indicates or suggests that a "selected privacy override code" is provided to the caller, particularly if the phone is in a privacy operating mode. The Office Action appears to acknowledge this defect in Khalid, as it states (emphasis added):

It is inherence that Khalid's device can also provide the caller with the means to override the privacy mode in case of emergency by giving out the override code in the message of answering machine. The

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description in Khalid is intended as illustrative only and is not to be interpreted in the limiting sense.

It is significant that the contention made in the Office Action is that the Khalid device "can" provide this feature of the claimed invention, but does not indicate what portion of the Khalid disclosure provides the disclosure of this function. Whether or not it is believed that the disclosure in the Khalid patent is "illustrative" or not, it must disclose the claimed feature or it is not anticipating. The Office Action points to a portion of the Khalid patent that clearly does not disclose this feature, and therefore it cannot be said that the claim is anticipated. The Office Action provides no reasoning why this feature of the claim would be inherent in the Khalid patent, and simply asserting that the disclosure is "illustrative" does not "inherently" anticipate other undisclosed features.

In fact, it is submitted that the Khalid patent would be more likely to lead one of ordinary skill in the art away from the claimed "a privacy mode message including a selected privacy override code" feature, as the Khalid patent specifically teaches that the caller is presented with a busy signal when the "Do Not Disturb" mode is enabled. See, e.g., Khalid at col. 5\, lines 41 through 43:

While in DND mode, telephone exchange system 30 returns a busy signal to all calls to subscriber telephone 31, as illustrated by a step 72.

It is believed that this portion of the Khalid patent is more likely to lead one of ordinary skill in the art to employ a busy signal than any "privacy mode message", especially one that includes a "privacy override code". See also the text in Khalid at col. 2, lines 36 through 44, where it is made clear that the caller is given a busy signal, at least until the caller is able to enter the pass code.

With respect to claim 7, which requires that the request further comprises "a privacy mode message selected by a user of the communication

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device and adapted to be provided to the caller prior to completing the call" and "the privacy mode code selected by the user of the communication device", claim 12 which requires that "the privacy mode message is selected from a group of prerecorded messages", claim 13 which requires that "the privacy mode message is recorded by a user of the communication device", claim 18 which requires that "the privacy mode message [is] selected by a user of the communication device and [is] adapted to be provided to the caller upon receiving the call", and claim 41 which requires "a privacy mode message selected by a user of the communication device and adapted to be provided to the caller prior to completing the call to the user". It is alleged in the Office Action that:

Regarding claims 7,12-13,18, and 41, Khalid further teaches a privacy mode message selected by a user of the communication device and adapted to be providing to the caller prior to completing the call and the privacy mode code selected by the user of the communication device (Col. 2, lines 61-64 and Col. 3, lines 1-6).

The Khalid patent at col. 2, line 61 through col. 3, line 10 (emphasis added):

In some situations, a call directed to the subscriber can get diverted to an adjunct processing system such as voice mail systems, auto-attendant, or an automatic call distribution (ACD) system. This happens when the subscriber fails or chooses not to answer the call personally. In these cases, in another preferred embodiment of the present invention, the caller can still enter the special pass code. The adjunct processor can recognize this pass code, and instruct the telephone system, via a command, to remove the call from the adjunct processing system and treat it as a special call. Alternatively, the telephone system can monitor the line for a special pass code and, upon detection of the special pass code, remove the call from the adjunct processing system and provide special treatment to the call. This special treatment results in, for example, applying a distinctive ringing to the subscriber telephone, and/or alerting the subscriber using an audio and/or visual indicator, as described above.

However, nothing here suggests that the user requests a user-selected privacy mode message to be provided to the caller when the device is in the Do Not Disturb mode. In fact, as noted above, the caller is subjected to a

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busy signal when the Khalid system is in the Do Not Disturb mode. The above portion of the Khalid patent states that the caller may be directed to a voice mail system "when the subscriber fails or chooses not to answer the call personally". This clearly suggests to one of ordinary skill in the art that the call has rung through to the user, as he or she could not choose to not answer the call if the system is in the "Do Not Disturb" mode. Again, since the caller is subjected to a busy signal in the DND mode, it does not suggest that the user would choose a "privacy mode message" or would record a "privacy mode message" provided to the caller when in the DND mode. It is therefore submitted that Khalid could not lead one of ordinary skill in the art to the requirements of claims 7, 12, 13, 18, and 41.

Claim 25 requires "a memory capable of storing a privacy mode message, the privacy mode message adapted to be provided to the caller prior to completing the call to the user". Claim 31 requires "a memory capable of providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user" As noted above, the Khalid patent teaches providing a busy signal to a caller when in the DND mode, so there is nor suggestion of the requirements of claim 25.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Khalid and Patsiokas set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 4, 5, 15, 16, 30 and 43.

Withdrawal of the §102(b) and §103(a) rejections of claims 1, 3 through 20, 22 through 37, 39 through 48, and 50 through 53 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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